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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

35901.3

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Dated by EFS-Web on February 26, 2008

Signature Susan C. LienTyped or printed name Susan C. Lien

Application Number

09/678,295

Filed

October 2, 2000

First Named Inventor

Entenmann, Mathias

Art Unit

3694

Examiner

Tran, Hai

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

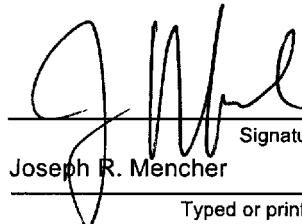
Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record. 56,822
Registration number _____.


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Telephone number

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.



*Total of one forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Entenmann, Mathias
Serial No. 09/678,295
Filed: October 2, 2000
For: METHOD OF EFFECTING CASHLESS
PAYMENTS AND A SYSTEM FOR
IMPLEMENTING THE METHOD

§
§ Confirmation No.: 4137
§ Group Art Unit: 3694
§ Examiner: Tran, Hai
§

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
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Responsive to the Final Office Action, dated February 4, 2008, please consider the following remarks in connection with the pre-appeal brief request for review. Review of the final rejection is requested for the following reasons.

1. **The rejection of claims 1-4, 7, 9-10, 12-19 and 22-32 under 35 U.S.C. 103(a) is not supported by the references as neither of the references teach every element of the claims.**

Claims 1-4, 7, 9-10, 12-19 and 22-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Partridge, III (U.S. Patent No. 5,608,778) (Partridge) in view of Jonstromer (U.S. Patent No. 6,142,369) (Jonstromer). Applicants respectfully submit that neither Partridge nor Jonstromer, alone or in combination, teach every element of any of the claims, for at least the reasons discussed below.

The Office Action uses Partridge to reject most elements of the claims and Jonstromer for the teaching of a cellular telephone with a smart card (or SIM card). Applicants respectfully submit that, in its use to provide a rejection under 35 U.S.C. 103(a), Partridge is deficient in a number of areas, detailed below, that Jonstromer does not remedy.

To summarize Partridge, a method to obtain credit with the use of a cellular telephone is disclosed having the following steps:

1. The telephone registers with a base station (column 3, lines 40-67 to column 4, lines 1-32)
2. The merchant provides the customer with a merchant ID code (column 5, lines 3-5)
3. The customer enters into the telephone a transaction prefix, the merchant ID, and a sum of money to be charged to the customers account and credited to the merchant (column 5, lines 6-9)
4. The telephone send the transaction prefix, the merchant ID, and the sum of money to the base station (column 5, lines 10-16)
5. The base station receives the transaction prefix, the merchant ID, and the sum of money, recognizes it as a credit request, and relays relevant information to a credit center (column 5, lines 17-26)
6. The credit center determines whether credit should be granted and sends an approval to the merchant and possibly the telephone (column 5, lines 27-30)

Partridge goes on to disclose that a "...slight awkwardness with the above-disclosed protocol is that the merchant needs to provide the customer with its code..." (column 5, lines 39-41) and that "...These deficiencies are overcome with a slightly altered approach where the merchant contacts credit center 40 – rather than the other way around – and where the merchant electronically supplies its identification code to the credit center..." (column 5, lines 48-52). Partridge goes on to state that a communications link between the telephone and the merchant is then "...established by the merchant and the customer agreeing to use a selected transaction password (TP string)...The customer can enter the TP string instead of the merchant's ID code and send that to base station 2, and the merchant can use the same TP in the merchant's communication with the credit center 40..." (emphasis added) (column 5, lines 55-62).

Independent claim 1 includes a number of elements (the underlined material below) that are not present in Partridge:

Transmitting an amount of money from the merchant station

There is no disclosure in Partridge of an amount of money transmitted from the merchant. As summarized above, the merchant either gives the customer a merchant ID code (column 5, lines 3-5) or a TP string (column 5, lines 55-62), and the customer then transmits the sum of money that should be charged to the customer's account and credited to the merchant (column 5, lines 6-9). The merchant is disclosed as transmitting, at most, the merchant ID code

(column 5, lines 48-52), the TP string (column 5, lines 55-62), and possibly the ESN and MIN1 of the telephone (column 6, lines 11-13).

Transmitting the identification code of the merchant from both of the merchant station and the mobile cell telephone

Partridge discloses transmitting the merchant ID code from either the merchant or the telephone, and teaches away from transmitting it from both. As detailed above, after disclosing that the merchant may provide the customer with a merchant ID code (column 5, lines 3-5) and the customer may then enter into the telephone the merchant ID (column 5, lines 6-9) and transmit the merchant ID code with the telephone, Partridge states that a "...slight awkwardness with the above-disclosed protocol is that the merchant needs to provide the customer with its code..." (column 5, lines 39-41) and that "...These deficiencies are overcome with a slightly altered approach where...the merchant electronically supplies its identification code to the credit center..." (column 5, lines 48-52) and "...The customer can enter the TP string instead of the merchant's ID code..." (emphasis added) (column 5, lines 55-62).

Writing the data transmitted from the merchant station to an open transaction and then comparing a merchant station identification code transmitted from the mobile cell telephone with the open transaction to find the transaction

As stated above, Partridge does not disclose that the merchant ID code is transmitted from both the merchant and the telephone, so there can be no disclosure that the transmission of the merchant ID code from the merchant is written to an open transaction and then a transmission of the merchant ID code from the telephone is compared with the open transactions to find that transaction.

Transmitting the transaction data to the mobile cell telephone and outputting the data through the mobile cell telephone

The Office Action states that such material is disclosed in Partridge at column 2, line 40 to column 7, line 23. As this is the entirety of the disclosure of the "Extending Credit" portion of Partridge, it is difficult for Applicants to determine exactly where the Office Action is asserting such material is disclosed. However, after a review of the section in its entirety, Applicants submit that no such disclosure exists. Partridge states "...When credit center 40 determines that telephone 10 should be granted the credit, it sends an approval code to merchant's equipment 30 and, perhaps, to the cellular telephone as well..." (column 5, lines 28-31), "...Preprocessor 42 confirms the bona fide of the user requested credit...and determines whether to grant credit. Its decision is then communicated to equipment 30 and, optionally, to wireless telephone 10. A written confirmation of the amount charged to the customer's account can be had from a

printout provided to the customer by the merchant and, if desired, the printout can be signed by the customer for a backup validation of the charge..." (column 6, lines 51-59). Thus, the only information sent to the telephone is an approval code or a decision to grant credit. Confirmation of an amount charged is not sent to the telephone, but rather provided as a printout by the merchant.

Requesting confirmation information through the mobile cell telephone and transmitting the confirmation data

The Office Action states that such material is disclosed in Partridge at column 2, line 40 to column 7, line 23. As this is the entirety of the disclosure of the "Extending Credit" portion of Partridge, it is difficult for Applicants to determine exactly where the Office Action is asserting such material is disclosed. However, after a review of the section in its entirety, Applicants submit that no such disclosure exists. There simply is no confirmation requested through the telephone. The only confirmation data sent seems to be the approval code or decision to grant credit that is sent to the telephone by the credit center (column 6, lines 51-59), but there is no confirmation request sent to the telephone or confirmation data sent from the telephone to the credit center.

Transmitting additional supplementary transaction data from the merchant station

The Office Action states that such material is disclosed in Partridge at column 2, line 40 to column 7, line 23. As this is the entirety of the disclosure of the "Extending Credit" portion of Partridge, it is difficult for Applicants to determine exactly where the Office Action is asserting such material is disclosed. However, after a review of the section in its entirety, Applicants submit that no such disclosure exists. As stated above, the merchant is disclosed as transmitting, at most, the merchant ID code (column 5, lines 48-52), the TP string (column 5, lines 55-62), and possibly the ESN and MIN1 of the telephone (column 6, lines 11-13). As further stated above, there is no disclosure of the merchant transmitting any transaction data, so there can be no disclosure of the transmission of additional supplementary transaction data.

Independent claim 3 includes the following limitations, similar to independent claim 1, that Partridge does not teach for the reasons stated above: transmitting the transaction data to the mobile cell telephone and outputting the data by the mobile cell telephone, and requesting confirmation information through the mobile cell telephone and transmitting the confirmation data. Furthermore, independent claim 3 includes the limitation: terminating the transaction if the confirmation information is not given within a predetermined time. The Office Action rejects claim 3 by stating that it is similar to claim 1 and has the same elements and limitations. However, this limitation is not provided in independent claim 1. As such, it is difficult for

Applicants to address the rejection. However, after a review of Partridge in its entirety, Applicants submit that no such disclosure exists, as Applicants can find no mention in Partridge of a predetermined time after which the transaction will be terminated if there is no confirmation. Such a conclusion is further supported, as stated above, by there being no confirmation requested from the telephone by the Partridge system.

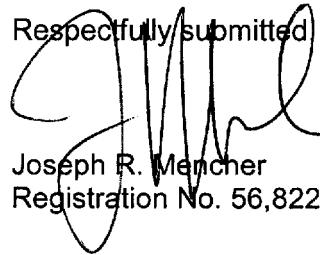
Independent claim 18 includes the following limitations, similar to independent claim 1, that Partridge does not teach for the reasons stated above: a control device that compares the identification code of the merchant station with the entries in the transaction data memory device and, on finding a transaction with the same merchant station identification code, transmits the located transaction data to the mobile cell telephone through the interface device for mobile cell telephone connections and also sends a request for confirmation thereto, and receives the confirmation data.

Independent claim 19 includes the following limitations, similar to independent claim 1, that Partridge does not teach for the reasons stated above: a control device transmits the transaction data to the mobile cell telephone and sends a request for confirmation to this, and receives the confirmation data.

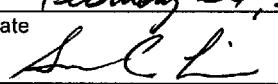
Therefore, independent claims 1, 3, 18 and 19 and the claim that depend from them are allowable for at least the reasons stated above.

Thus, these rejections rely on references that do not teach or suggest the claimed combination.

Other reasons for the patentability of claims 1-22 have been previously presented and will be maintained should the filing of an appeal brief become necessary.

Respectfully submitted

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